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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/706,296
Filing Date: November 03, 2000
Appellant(s): SRINIVAS ET AL.

John E. Harrity (43,367)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 01/14/2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Grounds of Rejection To Be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

6,701,368	CHENNAPRAGADA ET AL.	03-2004
6,300,947	KANEVSKY	09-2001
6,266,681	GUTHRIE	07-2001
6,230,171	PACIFICI ET AL.	05-2001

(9) Grounds of Rejection

Claims 1-4, 6, 8-10, 19 and 20 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,266,681 by Guthrie (hereinafter Guthrie) in view of U.S. Patent 6,230,171 by Pacifici et al. (hereinafter Pacifici). Note: This rejection is based on the explanation given by the Examiner in the advisory action (11/15/04) in response to the amendment filed 11/15/04 subsequent to the final rejection. The examiner stated in the advisory action: "All the claims would be rejected based on the same prior art cited in the final Office Action with the modification of Claims 1 and 19 now being rejected based on the combination of Guthrie and Pacifici in a similar manner as the previous rejection of claim 5 (now canceled)."

With respect to Claim 1, Guthrie teaches a method for inserting a toolbar into a webpage (Col. 3 lines 30-42) comprising: receiving a webpage at a remote server (Col. 5 lines 17-22 and Col. 7 lines 44-51) to be delivered to a client (Col. 3 lines 30-36); inserting an executable script (Col. 11 lines 31-53) into the webpage operable to render a toolbar when executed by a client browser (Col. 3 lines 30-41 and Col. 5 lines 45-58), the toolbar including at least one link to a resource (Col. 5 lines 45-58); and delivering the webpage including the executable script to the client (Col. 3 lines 30-41 and Col. 11 lines 31-53). Guthrie further teaches a webpage may have more than one frame (Col. 5 lines 41-45) and that an instance of an executable script may be inserted into a frame (Col. 3 lines 51-62) with the script operable to render the toolbar into that frame (Col. 6 lines 41-49 and Col. 5 lines 45-58). The toolbar can be considered an HTML component (Col. 3 lines 30-41). Guthrie also states that one skilled in the art would recognize variations to the code inserted based on the parameters of the HTML document (Col. 11 lines 25-32). Guthrie does not explicitly disclose an instance of the executable script being inserted into each frame of a webpage with more than one frame (The examiner notes that the claimed subject matter does not explicitly identify the webpage as having more than one frame. However, Guthrie describes embodiments that include multiple frames, which do not explicitly disclose executable script inserted in each of those frames). Pacifici teaches the use of a script (Col. 4 lines 27-35) that is inserted into each frame of a webpage that has more than one frame (Col. 5 lines 22-25). This script is operable to render HTML components into that frame (Col. 2 lines 59-67 and Col. 5 lines 22-38 of Pacifici). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to take the method disclosed by Guthrie and modify it as indicated by Pacifici such that the method further comprises inserting an executable script into each frame of the webpage operable to render the toolbar in each frame when executed by a client browser. One would be motivated to have this, as there is need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames (Col. 3 lines 1-29 of Guthrie).

With respect to Claim 2, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches the at least one link is a graphical link (Col. 5 lines 45-58 of Guthrie).

With respect to Claim 3, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches wherein the executable script is an activation script (Col. 11 lines 32-45 of Guthrie).

With respect to Claim 4, Guthrie in view of Pacifici teaches all the limitations of Claim 3 and further teaches the activation script determines whether the toolbar is rendered when the webpage is displayed at the client (Col. 15 lines 52-57 of Guthrie).

With respect to Claim 6, Guthrie in view of Pacifici teaches all the limitations of Claim 3 and further teaches for each instance of the activation script (Col. 5 lines 22-25 of Pacifici), the activation script determines whether the toolbar is displayed in an associated frame of the webpage when the webpage is displayed by the client (Col. 15 lines 45-47 of Guthrie).

With respect to Claim 8, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches the toolbar is a HTML toolbar (Col. 5 lines 4-12 of Guthrie),

and wherein the executable script is provided in a script programming language (Col. 11 lines 32-45 of Guthrie).

With respect to Claim 9, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches the resource is a remote third party resource (Col. 5 lines 45-58 of Guthrie).

With respect to Claim 10, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches the toolbar includes a plurality of links to different resources (Col. 5 lines 45-58 of Guthrie).

With respect to Claim 11, Guthrie in view of Pacifici teaches all the limitations of Claim 1 and further teaches said method further comprising: executing the executable script on the client machine to determine whether the toolbar should be displayed when displaying the webpage on the client machine (Col. 15 lines 38-57 of Guthrie).

With respect to Claim 19, Guthrie teaches a computer readable medium including at least computer program code for inserting a toolbar into a webpage at a server (Col. 3 lines 30-40), said computer readable medium comprising: computer program code for receiving a webpage at a remote server (Col. 5 lines 17-22 and Col. 7 lines 44-51) to be delivered to a client (Col. 3 lines 30-41); computer program code for inserting an executable script into the webpage (Col. 11 lines 31-53) operable to render a toolbar when executed by a client browser (Col. 3 lines 30-36 and Col. 5 lines 45-58), the toolbar including at least one link to a resource (Col. 5 lines 45-58) ; and computer program code for delivering the webpage including the executable script to the client (Col. 3 lines 30-41). Guthrie further teaches a webpage may have more than one frame

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(Col. 5 lines 41-45) and that an instance of an activation script may be inserted into a frame (Col. 3 lines 51-62) with the script operable to render the toolbar into that frame (Col. 6 lines 41-49 and Col. 5 lines 45-58). The toolbar can be considered an HTML component (Col. 3 lines 30-41). Guthrie also states that one skilled in the art would recognize variations to the code inserted based on the parameters of the HTML document (Col. 1.1 lines 25-32). Guthrie does not explicitly disclose an instance of the executable script being inserted into each frame of a webpage with more than one frame (The examiner notes that the claimed subject matter does not explicitly identify the webpage as having more than one frame. However, Guthrie describes embodiments that include multiple frames, which do not explicitly disclose executable script inserted in each of those frames). Pacifici teaches the use of a script (Col. 4 lines 27-35) that is inserted into each frame of a webpage that has more than one frame (Col. 5 lines 22-25). This script is operable to render HTML components into that frame (Col. 2 lines 59-67 and Col. 5 lines 22-38 of Pacifici). It would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Guthrie and modify it as indicated by Pacifici such that the computer readable medium further comprises computer program code for inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser. One would be motivated to have this, as there is need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames (Col. 3 lines 1-29 of Guthrie).

With respect to Claim 20, Guthrie in view of Pacifici teaches all the limitations of Claim 19 and further teaches the executable script determines whether the toolbar is displayed in the webpage when the webpage is displayed at the client machine (Col. 15 lines 38-57 of Guthrie).

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. 6,266,681 by Guthrie in view of U.S. Patent 6,230,171 by Pacifici et al. and further in view of U.S. Patent 6,300,947 by Kanevsky. This rejection is set forth in a prior office action mailed 08/18/2004.

Claims 17, 18 and 22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Guthrie in view of U.S. Patent 6,300,947 by Kanevsky and U.S. Patent 6,701,368 by Chennapragada et al.. This rejection is set forth in a prior office action mailed 08/18/2004.

(10) Response to Argument

With regards to Claim 1 (from the group of Claims 1-4, 6, 8-10, 19, and 20), Appellants argue on Page 6, second paragraph, of the Appeal Brief,

"For example, Guthrie and Pacifici et al. do not disclose or suggest inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser. The examiner admits that Guthrie does not disclose the above feature and relies on Col. 2, lines 59-67, and

col. 5, lines 22-38, of Pacifici et al. for allegedly disclosing this feature (final Office Action, pp.5-6). Appellants respectfully disagree that Pacifici et al. discloses this feature."

The examiner is at a loss as to what the Appellants are attempting to argue. Appellants repeatedly refer to a "feature", yet do not specifically describe a particular feature that is at issue. Appellants seem to be stating that neither the Guthrie reference nor the Pacifici reference individually teaches the cited limitation as a whole. The examiner rejected Claim 1 under 35 U.S.C. 103 (a) based on the combination of Guthrie in view of Pacifici et al. (hereinafter Pacifici). Contrary to Appellants' statement, the examiner does not admit in this rejection that Guthrie does not disclose this limitation. In fact the combination establishes that *"inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser"* would have been obvious to one of ordinary skill in the art. As such, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner believes a proper *prima facie* case was established for the rejection of Claim 1 (and related claims from this group) under 35 U.S.C. §103(a). As noted above in section '(9)', this rejection is based on the explanation given by the Examiner in the advisory action in response to the amendment filed 11/15/04 subsequent to the final rejection. The examiner stated in the advisory action: "All the

claims would be rejected based on the same prior art cited in the final Office Action with the modification of Claims 1 and 19 now being rejected based on the combination of Guthrie and Pacifici in a similar manner as the previous rejection of claim 5 (now canceled).” The previous rejection of claim 5 under 35 U.S.C. 103(a), presented on page 5 of the Final Office Action mailed 08/18/2004, was based on the combination of Guthrie and Pacifici and also dealt with the issue of obviousness in terms of the subject matter of scripts inserted into “each frame” of a webpage such that toolbars can be rendered in “each frame”. As such, the rejection of Claims 1 and 19 essentially reasserts all the previous limitations and obviousness issues still pertinent to the claimed subject matter.

The rejection sets forth the scope and content of the prior art, the Guthrie reference. Guthrie teaches the majority of the claimed limitations as claimed in claim 1. Guthrie is cited as teaching receiving a webpage at a remote server (Col. 5 lines 17-22 and Col. 7 lines 44-51) to be delivered to a client (Col. 3 lines 30-36); inserting an executable script (Col. 11 lines 31-53) into the webpage operable to render a toolbar when executed by a client browser (Col. 3 lines 30-41 and Col. 5 lines 45-58), the toolbar including at least one link to a resource (Col. 5 lines 45-58); and delivering the webpage including the executable script to the client (Col. 3 lines 30-41 and Col. 11 lines 31-53). Guthrie further teaches a webpage may have more than one frame (Col. 5 lines 41-45) and that an instance of an executable script may be inserted into a frame (Col. 3 lines 51-62) with the script operable to render the toolbar into that frame (Col. 6 lines 41-49 and Col. 5 lines 45-58). The toolbar can be considered an HTML

component (Col. 3 lines 30-41). Guthrie also states that one skilled in the art would recognize variations to the code inserted based on the parameters of the HTML document (Col. 11 lines 25-32).

The rejection states the difference between the prior art and the claims in issue. The primary difference between Guthrie and the claimed limitations is in regards to the claim language "each frame". Particularly, while Guthrie describes inserting an executable script into a frame of a webpage, Guthrie does not explicitly teach inserting a script into "each frame" of a webpage with multiple frames. This difference is described by the rejection, which states,

"Guthrie does not explicitly disclose an instance of the executable script being inserted into each frame of a webpage with more than one frame (The examiner notes that the claimed subject matter does not explicitly identify the webpage as having more than one frame. However, Guthrie describes embodiments that include multiple frames, which do not explicitly disclose executable script inserted in each of those frames)."

As stated earlier, contrary to Appellants statement, the rejection does not state that Guthrie does not disclose *"inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser"*.

Pacifici is cited as teaching the use of a script (Col. 4 lines 27-35) that is inserted into each frame of a webpage that has more than one frame (Col. 5 lines 22-25). This script is operable to render HTML components into that frame (Col. 2 lines 59-67 and Col. 5 lines 22-38 of Pacifici).

The rejection states that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the method disclosed by Guthrie and modify it as indicated by Pacifici such that the method further comprises inserting an executable script into each frame of the webpage operable to render the toolbar in each frame when executed by a client browser. Guthrie provides the motivation for making such a combination. As stated in the rejection, "One would be motivated to have this, as there is need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames (Col. 3 lines 1-29 of Guthrie)". In the advisory action mailed 11/15/04, the examiner further commented in response to Appellants' arguments on the motivation aspect. The examiner stated that Guthrie describes in col. 3, lines 1-29, the need and desire for add-on components for a web page. The need and desire comes from benefits such as easier navigation (col. 3 lines 7-9). If there is need or desire for an end result, it is logical that one would be open to modifications and alternatives to achieve the end result.

After stating their initial argument, Appellants then present arguments concerning examiner's reliance on Pacifici. Starting on page 6 of the Appeal Brief, Appellants cite col. 2, lines 59-67 of Pacifici and state,

"This section of Pacifici et al. discloses the ability to dynamically add HTML annotations to HTML documents. This section of Pacifici et al. does not disclose or suggest that annotations are toolbars or the rendering of a toolbar in each frame of a webpage, as required by claim 1. In fact, Pacifici et al. specifically discloses that the annotations are markups that participants of a web-based collaboration system make to documents. Moreover, even assuming, for the sake of argument, that one skilled in the art could reasonably construe Pacifici et

al.'s annotations to be toolbars, this section of Pacifici et al. does not disclose or suggest inserting the annotations into each frame of a webpage that is operable to render a toolbar in each frame when executed by a client browser, where the toolbar includes at least one link to a resource."

Appellant is again, using a piecemeal argument that individually attacks the Pacifici reference and does not consider the combination of Guthrie and Pacifici as set forth in the rejection of claim 1. Pacifici is not cited to teach that annotations are toolbars or rendering of a toolbar in each frame of a webpage. Guthrie already discloses the implementation and rendering of a toolbar in a frame, with the toolbar including at least one link to a resource (Col. 3 lines 30-41 and Col. 5 lines 45-58 and See Fig. 3 item 305). Pacifici is cited to show the subject matter of inserting a script into each frame of a webpage with multiple frames (Col. 5 lines 22-25). This section states

"Since HTML documents can be composed of multiple frames or windows, a markup agent 412 is associated with each frame. The agent has several responsibilities within its frame including:..." (note the markup agent is a executable script, see Col. 4 lines 27-35 and lines 55-58).

Further evidence of script insertion into each frame is noted in Col. 4 lines 13-15, which states "the collaboration server modifies the retrieved document to insert the JavaScript-based markup components", in Col. 8 lines 15-18 "An HTML document may be composed of a number of frames (or windows). The Web document processor associates a markup agent, in the form of a client side script, with each frame" and in Col. 8 lines 38-40 which states "For this purpose, each markup agent needs to be able

to recognize the name of the frame in which it is running" (emphasis added). Each of these scripts include functionality for dynamically adding an HTML component to its associated frame (Col. 2 lines 59-67). Col. 5, lines 22-38 specifically lists this functionality as the agent's responsibility. Logically this corresponds from a technical point of view with the teachings of Guthrie since the toolbar in Guthrie is associated with an executable script (Col. 11 lines 31-53) inserted into a frame of a webpage and is an HTML component in certain embodiments (Col. 3 lines 30-41). The rejection further provides motivation for this combination. Furthermore, Appellants do not state the significance of their statement on the disclosure of Pacifici in terms of the non-obviousness of the claimed subject matter.

The response just given also applies to the arguments given by Appellants in regards to col. 5, lines 22-38 of Pacifici on page 7 of the Appeal Brief. Appellants argue,

"This section of Pacifici et al. in no way discloses or suggests inserting an executable script into each frame of the webpage operable to render a toolbar in each frame when executed by a client browser, where the toolbar includes at least one link to a resource, as required by claim 1. Moreover, Pacifici et al. does not disclose that they dynamic HTML components are toolbars."

Appellants again do not consider what the combination of Guthrie and Pacifici would have suggested to one of ordinary skill in the art. As stated earlier, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. Furthermore, Appellants' arguments are merely conclusive statements that do not rely on any factual evidence in relation to the cited

prior art or errors on the part of the examiner in interpreting the prior art and making the rejection.

On page 8 of the Appeal Brief, the Appellants argue with respect to a statement made by the examiner in the advisory action mailed 11/15/04 (see Continuation of 5, first argument). The examiner stated that the capability of inserting executable script into each frame of the webpage, while not explicitly taught, was implied based on the fundamental concept explicitly disclosed by Guthrie. Appellants argue the cited section, col. 6, line 41-56, "in now way implies" such a capability. While this particular statement given in the advisory action is not relied upon in the rejection of Claim 1, the examiner will clarify the interpretation as it is pertinent to the scope of Guthrie. This section states that the injected code "*contains instructions that specifically cause the WEB browser 401 to conditionally insert HTML tag statements (HTML code) into the document 407 when the browser executes the injected code.*" In other words, an executable script (injected code) when executed causes an HTML code (an HTML component) to conditionally be placed in a document. As noted before, a toolbar is considered an HTML component in certain embodiments of Gurthrie. When this HTML code is executed, the component (the toolbar) is generated and displayed (rendered). This section further explicitly states, "*The conditions are determined by the injected code itself*". It is important to note that HTML code (the toolbar) is conditionally placed in the document, such as a webpage, and that this condition is determined by the executable script (injected code). Obviously Guthrie implies there are other embodiments besides those disclosed that can make use of different conditions to determine the insertion and

rendering of injectable components. This would include conditions where more than one instance of an injectable component may be rendered in more than one frame. The examiner realizes though that this interpretation of Guthrie would not necessarily provide sufficient evidence of unpatentable subject matter and admits to such in the advisor action of 11/15/04. The examiner stated, *"To make the rejection proper though, Pacifici is used to teach the functionality of inserting script into each frame of a webpage."*

In the first paragraph of page 9 of the Appeal Brief, Appellants argue

"The Examiner further relies, in the Advisory Action, dated November 15, 2004, on col. 4, lines 13-15, and col. 8, lines 15-18 and 38-40, of Pacifici et al. for allegedly disclosing "script insertion into each frame" (Advisory Action, Continuation Sheet). Regardless of the veracity of this allegation, Appellants submit that Pacifici et al. does not disclose or suggest inserting an executable script into each frame of a webpage that is operable to render a toolbar in each frame when executed by a client browser, as required by claim 1."

Again, Appellants make conclusive statements that do not rely on any factual evidence in relation to the cited prior art or errors on the part of the examiner in interpreting the prior art and making the rejection. Appellants again ignore what the combination of Guthrie and Pacifici as stated in the rejection of claim 1, would have suggested to one of ordinary skill in the art. As stated earlier, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

On pages 9 and 10 of the Appeal Brief, Appellants argue

"Appellants submit that one skilled in the art would not have been motivated combine this alleged teaching of Pacifici et al. with the disclosure of Guthrie, absent impermissible hindsight...Appellants submit that the Examiner's allegation with respect to motivation is merely conclusory. The Examiner has not explained why one skilled in the art would seek to modify the system of Guthrie to include Pacifici et al.'s alleged teaching... it is unclear how the Examiner can allege that modifying the Guthrie system to include the alleged feature of Pacifici et al. would allow Guthrie to perform a function that Guthrie already performs."

The examiner reasserts his response given in the advisory action, mailed 11/15/05, to a similar argument with regards to the motivation. The examiner feels the motivation to combine Guthrie and Pacifici is self evident in Guthrie. Specifically, the examiner cited Col. 3 lines 1-29 as it describes the need for a user to be able to incorporate add-on components in a webpage including webpages with multiple frames. The need and desire come from benefits such as easier navigation, for example, (Col. 3 lines 7-9). If there is need or desire for an end result, it is logical that one would be open to modifications and alternatives to achieve the end result.

On page 10 of the Appeal Brief, Appellants begin their arguments in regards to the rejection of Claim 7 under 35 U.S.C. §103(a) based on the combination of Guthrie, Pacifici, and U.S. Patent 6,300,947 by Kanevsky (hereinafter Kanevsky).

On page 11 of the Appeal Brief, Appellants state that Guthrie, Pacifici and Kanevsky *"do not disclose or suggest determining a size of each frame in which the toolbar is to be displayed using the activation script inserted into each frame."*

Appellants further state that the examiner admits Guthrie and Pacifici do not teach this feature. The examiner notes that this is not the difference between the prior and the

claim limitations that the rejection sets forth. In the rejection of Claim 7 (See Final Action mailed 8/18/04, page 8), Guthrie in view of Pacifici has shown the insertion of the script into each frame to render a toolbar in each frame as being obvious. The scope of Guthrie in view of Pacifici also teaches conditionally displaying a toolbar based on conditions determined by the activation script (Col. 6 lines 41-56 of Guthrie). The claim limitations describe subject matter involving rendering the toolbar based on a condition. The condition involves determining the size of each frame and comparing that size to a threshold. As such, the rejection sets for the difference as follows "*Guthrie in view of Pacifici...does not explicitly disclose determining a size of each frame of the webpage using the activation script and the condition for rendering specified by the activation script being a threshold size compared to the determined size of the frame.*"(emphasis added). The rejection then states the teachings of Kanevsky as follows:

"Kanevsky teaches a system for conditionally adding webpage components depending on the size of the viewing area (col. 2 lines 12-19 and Col. 10 lines 45-51). The system determines the size of the viewing area and only displays the components (or components) if it will fit the viewing area (Col. 10 lines 45-62). In other words, if the size of a viewing area exceeds a threshold size (the combined size of the additional component(s) and the original content in this case) then the component will be displayed."

It is obvious that Kanevsky discloses a technical feature of determining a size of a viewing area, which the examiner considers to include a "frame" based on Col. 1, lines 43-47 of Kanevsky. Kanevsky further shows a comparison of this size to a threshold size which is further involved in the condition display (ie. rendering) of a webpage component. This relates directly to the claim limitations as well as the conditional

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rendering of the toolbar in each frame as disclosed by Guthrie in view of Pacifici. Based on the teachings of Guthrie, Pacifici, and Kanevsky as described and consider as a whole, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make to make combination as asserted by the rejection. The rejection further provides motivation as to why one would make the combination.

Appellants' arguments on pages 11-12 of the Appeal Brief, are primarily directed towards attempts to find the entire expressed feature in each individual column and line citation. The Appellants do not take into consideration what the combination of Guthrie, Pacifici, and Kanevsky as a whole would have suggested to one of ordinary skill in the art. As stated earlier, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

Furthermore, Appellants arguments with regards to Kanevsky, seem to conflict. On page 12 of the Appeal Brief, Appellants state that Col. 10, lines 45-62 of Kanevsky *"discloses determining whether to render objects...based on the size of the objects and the screen size."* Then, on the same page, in regards to a certain embodiment of Kanevsky, Appellants state, *"Kanevsky does not disclose or suggest determining a size of a screen."*

On page 13 of the Appeal Brief, Appellants begin arguments in regards to the rejection of Claims 17, 18 and 22 under 35 U.S.C. §103(a) based on Guthrie, Kanevsky, and U.S. Patent 6,701,368 by Chennapragada et al. (hereinafter Chennapragada).

The examiner notes that Appellants arguments in regards to claims 17, 18 and 22 are again focused on an individual reference in a rejection based on a combination of prior art. Particularly, Guthrie is singled out. While it is important to ascertain that the scope of a particular reference was interpreted properly, it is also important to consider a rejection based on a combination of prior art as a whole. This is reflected in *In re Keller, Terry, and Davies* 208 USPQ 871 (CCPA 1981),

"Test of obviousness is not whether features of secondary reference may be bodily incorporated into primary reference's structure, nor whether claimed invention is expressly suggested in any one or all of references; rather test is what combined teachings of references would have suggested to those of ordinary skill in the art."

Appellants fail to consider what the combined teachings of references would have suggested to those of ordinary skill in the art. Appellants only provide the conclusive statement on page 14 of the Appeal Brief, *"The disclosures of Kanvesky and Chennapragada et al. do not remedy the above deficiency in the disclosure of Guthrie."*

Starting at the end of page 13 and continuing onto page 14, Appellants argue, *"At the outset, it is unclear as to how the Examiner can admit, on the one hand, that Guthrie does not disclose rendering a toolbar in each frame of a webpage (see final Office Action, pg. 5) and then, on the other hand, allege that Guthrie discloses the very feature that the Examiner admits Guthrie does not disclose. Contrary to the Examiner's allegation with respect to claim 17, Appellants submit that Guthrie does not disclose or suggest rendering a toolbar in each frame of a webpage."*

The examiner indicated in the advisory action mailed 11/15/04, that the rejection of claim 17 does not allege such a statement in regards to Guthrie. From page 5 of the Final Office Action (8/18/04): "Guthrie does not explicitly disclose an instance of the activation script being inserted into each frame of a webpage with more than one frame." This does not state that Guthrie does not disclose the ability to graphically render a toolbar in each frame. Furthermore, the statement of from page 5 of the Final Office Action (8/18/04), is from the rejection of then pending Claim 5, which is now essentially the context of the rejection of Claim 1. The claimed subject matter of claim 17, while related, is not interpreted in the same context. Particularly, the examiner asserts there is a difference between "inserting" a script into each frame of a webpage, and the ability to render a toolbar for each frame of a webpage. The claim language of claim 17 does not state the "insertion" of activation script into each frame of a webpage with more than one frame. Claim 17 states in lines 4-6, "*computer program code for determining whether an activation script for rendering a toolbar is within HTML code for each frame of a webpage having more than one frame*". The examiner interprets this as a determination of or checking for the presence of an activation script within each frame of a webpage page having more than one frame. The rejection of claim 17 cites Guthrie as teaching an activation script (Col. 11 lines 31-53) for rendering a toolbar (Col. 3 lines 30-41 and Col. 5 lines 45-58) and that in one embodiment, when a webpage is loaded, each frame can be checked for the presence of activation script which renders a toolbar (Col. 15 lines 38-57). This is not alleging that Guthrie teaches an instance of the

activation scripting being inserted into each frame of a webpage with more than one frame.

Also in regards to this argument as well as the arguments directed to col. 6, lines 41-56 of Guthrie (bottom of Page 14 of the Appeal Brief), the rejection (Page 7 of Final Office Action 8/18/04) further states that Guthrie teaches "*computer program code for displaying the toolbar in each frame based on conditions specified by the activation script (Col. 6 lines 41-56). Based on the specified conditions, the toolbar is either rendered or not rendered (Col. 6 lines 41-56)*" (emphasis added). This cited section of Guthrie was described above in regards to the examiners interpretation. The examiner interpreted the section as describing an executable script (injected code) that when executed causes an HTML code (an HTML component) to conditionally be placed in a document. As noted before, a toolbar is considered an HTML component in certain embodiments of Gurthrie. When this HTML code is executed, the component (the toolbar) is generated and displayed (rendered). Of particular interest to the rejection of claim 17 is the part of the section that states, "*The conditions are determined by the injected code itself*". The HTML code (the toolbar) is conditionally placed in the document, such as a webpage, and the condition is determined by the executable script (injected code). This implies there are other embodiments besides those explicitly disclosed by Guthrie, that can make use of different conditions to determine the rendering of injectable components. This would include conditions where more than one instance of an injectable component may be rendered in more than one frame. It is important to note that the relevance of this interpretation is more pertinent to the

rejection of claim 17, as the context of the subject matter of claim 17 is different than the context of the subject matter of claim 1. Claim 1 is in the context of "insertion" of a script, which is capable of rendering a toolbar. Claim 17 describes conditional rendering of the toolbar in each frame based on the size of a frame, which is in the context of *"determining whether a toolbar should be displayed in one or more frames of a webpage"*, as stated in the preamble. As such, the rejection of Claim 17 is in context to such a conditional determination. When the teachings of Guthrie in combination with the teachings of Kanevksy and Chennapragada are considered as a whole, the claimed invention is obvious as presented in the rejection of claim 17.

On page 14 of the Appeal Brief, Appellants argue,

"Guthrie specifically discloses that the system ensures that only one instance of injectable component 305, which the Examiner alleges corresponds to the recited toolbar, is generated and displayed in browser application window 303 (col. 5, lines 63-67), which includes, as illustrated in Fig. 3, three separate frame. This section of Guthrie clearly contradicts the Examiner's position that Guthrie's system renders a toolbar in each frame 306-308 of a webpage."

Also in relation to this argument, Appellants state on page 15 (3rd paragraph) of the Appeal Brief,

"Therefore, Guthrie teaches away from rendering a toolbar in each frame of a webpage. The Examiner continues to ignore this argument."

The examiner has not ignored this argument. In the Final Office Action (8/18/04), on pages 10-11, paragraphs 34 and 34.c, the examiner stated that Guthrie was not limited to the particular embodiment to which the Appellants are referring. Specifically, Guthrie explicitly states in relation to ensuring only one instance of the component being

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displayed that this occurs "In one embodiment" (Col. 13 lines 40-42 and Col. 5 lines 49-51) or that the system "preferably determines" (Col. 15 lines 45-48). Furthermore, the fact that Guthrie discloses such a checking mechanism further supports interpretation that Guthrie expects other embodiments where multiple toolbars can be potentially displayed in multiple frames. Otherwise, why would there be such a checking mechanism.

Furthermore, Fig. 3 does not contradict the Examiner's position, as the Examiner's position in the rejection of claim 17 states that Guthrie teaches "*computer program code for displaying the toolbar in each frame based on conditions specified by the activation script (Col. 6 lines 41-56). Based on the specified conditions, the toolbar is either rendered or not rendered (Col. 6 lines 41-56)*" (emphasis added)." This does not state the position that Guthrie's system renders a toolbar in each frame of a webpage. This shows that Guthrie teaches the capability of conditionally displaying a toolbar in a frame and that Guthrie obviously acknowledges webpages with one or frames based on the overall disclosure. When the teachings of Guthrie in combination with the teachings of Kanevksy and Chennapragada are considered as a whole, the claimed invention is obvious as presented in the rejection of claim 17. Furthermore the claim language does not necessarily require "rendering a toolbar in each frame of a webpage" as the preamble of claim 17 states, "*determining whether a toolbar should be displayed in one or more frames of a webpage*". Fig. 3 of Guthrie also shows a toolbar displayed in one or more frames of a webpage. The display of this toolbar is conditionally determined based on col. 6, lines 41-56 of Guthrie.

On Page 15 of the Appeal Brief and in regards to the examiner's interpretation of col. 6 lines 41-56, Appellants argue,

"Contrary to the Examiner's allegation, Guthrie does not disclose or suggest rendering a toolbar in each frame of a webpage. The mere fact that Guthrie discloses rendering a toolbar in a webpage and that a webpage can include multiple frames would not reasonably lead one skilled in the art to conclude that Guthrie discloses rendering a toolbar in each frame of a webpage, as required by claim 17."

The examiner did not determine his interpretation of col. 6, lines 41-56 of Guthrie on the mere fact that Guthrie discloses rendering a toolbar and that there can be multiple frames in the web page. As stated previously, col. 6, lines 41-56 of Guthrie describes the conditional rendering of injectable components in a webpage and that the conditions are determined by the activation script. The examiner's interpretation is based on this idea of conditionally determining whether or not to display a toolbar in a webpage. As stated previously, the rejection of claim 17 states that Guthrie teaches *"computer program code for displaying the toolbar in each frame based on conditions specified by the activation script (Col. 6 lines 41-56). Based on the specified conditions, the toolbar is either rendered or not rendered (Col. 6 lines 41-56)"* (emphasis added)." This does not state the position that Guthrie's system renders a toolbar in each frame of a webpage. This shows that Guthrie teaches the capability of conditionally displaying a toolbar in a frame and that Guthrie obviously acknowledges webpages with one or frames based on the overall disclosure. When the teachings of Guthrie in combination with the teachings of Kanevksy and Chennapragada are considered as a whole, the claimed invention is obvious as presented in the rejection of claim 17.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



David Lazaro
April 4, 2005

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